

T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 11/13/82

TO: EXAMINER Stock

**FROM:** Macaluso, Jo

## **PARALEGAL SPECIALIST**

APPL. S.N.:

09/579593

ART-UNIT;

2877

RETURN THIS MEMO TO: CP4-6D28

**SUBJECT:** Decision on Terminal Disclaimer (T.D.) filed:

11/4/02

**INSTRUCTIONS:** I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this Informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE.

The T.D. is PROPER and has been recorded (see § 14.23).

The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see § 14.24):

The TD fee of [REDACTED] has not been submitted nor is there any authorization in the application file for the use of a deposit account (see § 14.26.07).

The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see §§ 14.26 & 14.26.01).

The T.D. lacks the enforceable only during common ownership clause - needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see § 14.27.01).

The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be for a terminal portion of the term of the entire patent to be granted" (MPEP 1490) (see §§ 14.26 & 14.26.02).

The person who signed the T.D.:

is not an attorney "of record" (see §§ 14.29 and 14.29.01).

has failed to state his/her capacity to sign for the business entity (see § 14.28).

is not recognized as an officer of the assignee (see §§ 14.29 & possible 14.29.02).

No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see § 14.30).

The T.D. is not signed (see §§ 14.26 & 14.26.03).

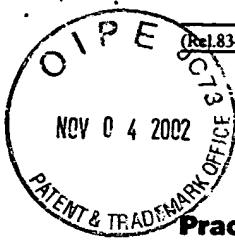
The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see § 14.32).

The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed) is missing or incorrect (see §§ 14.26, 14.27.02 or 14.26.05).

The period disclaimed is incorrect or not specified (see §§ 14.26, 14.27.02 or 14.26.03).

Other: [REDACTED]

Suggestion to request refund (see § 14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.



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TECHNOLOGY CENTER 2800  
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17  
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PATENT

(Ref.83-400 Pub.605)

NOV 12 2002

OFFICE OF THE SPECIAL  
PROGRAMS EXAMINER

Practitioner's Docket No. 81329A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Joseph J. Danko

Application No.: 09 / 579,593 Group No.: 2877

Filed: 5-26-00

Examiner: Gordon J. Stock Jr.

For: METHOD AND APPARATUS FOR INSPECTING A PATTERNED SEMICONDUCTOR  
WAFER

\*Patent No.:

Issue Date:

Reexamination No.:

\*NOTE: Preferably also insert inventor's name and invention title.

Assistant Commissioner for Patents  
Washington, D.C. 20231

11/05/2002 DTESSH1 00000075 09579593

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110.00 OP

**TERMINAL DISCLAIMER TO OBLIGATE  
A DOUBLE PATENTING REJECTION (37 C.F.R. § 1.321(c))**

**Identification of Person(s) Making This Disclaimer**

I, IRVING M. KRIEGLSMAN

(type or print names of all inventors or assigns or name of attorney signing disclaimer)

(a) represent that I am

an inventor (applicant) of this invention.  
 an assignee of this invention.

**WARNING:** "If the patent or patent application is assigned to an organization, such as a corporation, partnership, university, [g]overnment agency or similar entity, and the disclaimer is signed by the assignee, the assignee must comply with § 3.73(b)." Notice of Oct. 15, 1993, 1156 O.G. 54-61 at 56, § 1490, M.P.E.P., 7th Edition.

a representative authorized to sign on behalf of the assignee identified below.  
 A statement under 37 C.F.R. § 3.73(b) is attached.

**WARNING:** See the above "WARNING".

the attorney of record for this invention.

**NOTE:** The rules "permit an attorney or agent of record to sign a terminal disclaimer without the need to comply with § 3.73(b)." Notice of Oct. 15, 1993, 1156 O.G. 54-61, at 56. See also § 1490, M.P.E.P., 7th Edition.

**CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8(a))**

I hereby certify that this correspondence is, on the date shown below, being:

**MAILING**

deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

**FACSIMILE**

transmitted by facsimile to the Patent and Trademark Office, (703) \_\_\_\_\_

Signature

Irving M. Kriegsmann

(type or print name of person certifying)

Date: 10-30-02

**IDENTITY OF ASSIGNEE AND TITLE OF DISCLAIMANT**  
*(if applicable)*

The assignee is

Name of assignee \_\_\_\_\_

Address of assignee \_\_\_\_\_

Title of disclaimant authorized to sign on behalf of assignee \_\_\_\_\_

**EXTENT OF DISCLAIMER'S INTEREST**

The extent of the interest in this invention that the disclaimant owns is in:

- the whole of this invention.
- a sectional interest in this invention, as follows:

*(state the exact interest of the disclaimant)*

**RECORDAL OF ASSIGNMENT IN PTO**  
*(if applicable)*

- The assignment was recorded on \_\_\_\_\_  
Reel \_\_\_\_\_  
Frame \_\_\_\_\_
- Authorization for recordal of the assignment is separately attached.
- A separate  "ASSIGNMENT (DOCUMENT) COVER SHEET" or  
 FORM PTO 1595 is also attached.

**ESTABLISHING RIGHT OF ASSIGNEE TO TAKE ACTION**  
*(if applicable)*

- Attached is a STATEMENT UNDER 37 C.F.R. § 3.73(b) establishing the right of the assignee to take action in this case.

NOTE: Insert the appropriate page 3.

(Terminal Disclaimer to Obviate a Double Patenting Rejection [9-4]—page 2 of 4)

**DISCLAIMER**  
**(Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application)**

Petitioner(s) hereby disclaims, except as provided below, the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of any patent granted on Application No. 09 / 518,977, filed on 3-4-00, as shortened by any terminal disclaimer. Petitioner(s) hereby agree(s) that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the above-listed application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

In making the above disclaimer, disclaimant does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of any patent granted on the application forming the basis of the double patenting rejection, namely, any patent granted on Application No.: 09 / 518,977, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

**DISCLAIMER FEE (37 C.F.R. § 1.20(d))**

- Other than a small entity — fee \$110.00
- Small entity — fee \$55.00
  - Small entity statement attached
  - Small entity statement already filed
    - in patent application \_\_\_\_\_ / \_\_\_\_\_  
on \_\_\_\_\_ (date)

**FEE PAYMENT**

Attached is a check in the sum of \$110.  
 Charge Account 11-1755 for any fee deficiency.  
 Charge Deposit Account \_\_\_\_\_ the sum of \$\_\_\_\_\_.

A duplicate of this disclaimer is attached.

TERMINAL DISCLAIMER  
APPROVED

NOV 15 2002  
*J. Meccles*  
TECHNOLOGY CENTER 2800  
SPECIAL PROGRAM CENTER

Date: 10/30/02

Reg. No.: 22,733

Customer No.: 1111111111111111

23685

Signature of disclaimant

*Irving M. Kriegsman*  
SIGNATURE OF PRACTITIONER OF RECORD

IRVING M. KRIEGSMAN

(type or print name of practitioner)  
KRIEGSMAN & KRIEGSMAN  
665 Franklin Street

P.O. Address

Framingham, MA 01702